



EV175420857US

10/10/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: )

LUFFEL, Robert, W., et al. )

Serial No. 10/051,573 )

Filing Date: January 17, 2002 )

For: LOW PROFILE SUPPORT SYSTEM )  
FOR DEVICE RACK-MOUNTING )

Examiner: Tran, Khoa, H.

Art Unit: 3634

Conf. No.: 1003

Atty. Dkt.: 10001582-5

## RESPONSE TO SECOND NOTIFICATION OF NON-COMPLIANCE

To: The Commissioner of Patents and Trademarks  
P.O. Box 1450  
Arlington, VA 22313-1450RECEIVED  
OCT 07 2003  
GROUP 3600

Sir:

This communication is in response to the Notification of Non-Compliance, paper no. (unspecified), dated September 26, 2003.

In the Notification of Non-Compliance, the examiner takes the position that the reply containing the amended Appeal Brief filed by appellants on June 30, 2003 was not fully responsive in that the Appeal Brief failed to "provide separate arguments for the claims as stated by the 'Grouping of Claims' or otherwise set forth a 'grouping' of the claims that corresponds to the claims argued." See p. 2 of the Notification of Non-Compliance.

In response, appellants respectfully submit that their reply and amended Appeal Brief filed on June 30, 2003, was fully responsive to the examiner's first Notification of Non-Compliance. 37 C.F.R. 1.192(c)(7) states as follows:

"Grouping of Claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, **the Board shall select a single claim from the group** and shall decide the appeal as to the ground of rejection on the basis of that claim alone **unless a statement is included that the claims**

of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, **appellant explains why** the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." (Emphasis added)

Section 1.192(c)(7) is permissive with regard to the appellant. That is, this section is directed to what the Board must do in considering the appeal, not what the appellant should do in preparing the appeal brief. It merely allows the appellant the option of having each claim independently considered by the Board. Stated another way, 37 C.F.R. 1.192(c)(7) provides that **unless** a statement is included (in the appeal brief) regarding the grouping of the claims (and arguments provided), "the Board shall select a single claim." Clearly then, the appellant could omit such a statement regarding the grouping of the claims and still be in compliance with 1.192(c), so long as the other subsections (which are requirements of appellant) are met.

Based on the clearly permissive nature of 37 C.F.R. 1.192(c)(7), appellants again respectfully submit: (1) That their original appeal brief was in full compliance with 1.192(c); (2) That their amended appeal brief filed on June 30, 2003, was in full compliance with 1.192(c); and (3) that the attached second amended appeal brief is fully compliant with 1.192(c). All briefs previously filed by appellants contained the (optional) statement about the grouping of the claims, and presented arguments in support thereof. While it may be that the Board would find such arguments unpersuasive, that is a question for the Board, not whether the brief fails to comply with 37 C.F.R. 1.192(c).

On October 1, 2003, the undersigned counsel for appellants conducted an extensive telephone interview with the examiner's supervisor, Daniel P. Stodola. This telephone interview was conducted in an effort to determine the specific issues the Patent Office wanted addressed in the second Notification of Non-

Compliance in order to avoid having the Office find appellants' response again to be non-compliant. The requirements of 37 C.F.R. 1.192(c) were discussed at length, as was appellants' position that their first reply and amended Appeal Brief were fully compliant with 37 C.F.R. 1.192(c). The undersigned counsel also expressed concern about the nearly two-month delay between when appellants submitted their reply (mailed June 30, 2003) to the first notice of non-compliance and the issuance of second notification of non-compliance (mailed September 26, 2003). Mr. Stodola offered no explanation for the delay, but agreed it was too long.

While not admitting that their first response, or even the original Appeal Brief was non-compliant with 37 C.F.R. 1.192(c), for the reasons stated herein, appellants include herewith a second amended Appeal Brief in triplicate wherein the "Grouping of the Claims" section is again amended to identify those claims that stand for fall together within the particular ground of rejection.

Accordingly, appellants believe that the amended appeal brief filed concurrently herewith is fully compliant with 37 C.F.R. 1.192(c).

Respectfully submitted,

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